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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,080	07/24/2003	David C. Eby	29618/EL013	9963
4743 7590 05/12/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606				
EXAMINER				
QUINN, COLLEEN M				
ART UNIT		PAPER NUMBER		
3634				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/626,080

**Applicant(s)**

EBY ET AL.

**Examiner**

COLLEEN M. QUINN

**Art Unit**

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-21, 24, 27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-21, 24, 27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Clarifications***

*It is not clear if applicant is invoking 35 USC 112 paragraph 6. Examiner notes from Chapter 2100 of the current MPEP, section 2181:*

*A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:*

- (A) the claim limitations must use the phrase "means for" or "step for";*
- (B) the "means for" or "step for" must be modified by functional language; and*
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.*

Currently it appears the applicant's "means for securing" (claim 27), do not meet the three-prong analysis due to the claim language being modified by sufficient structure since the securing means are specified as being attached to the plate through a hole in the plate.

However, if the applicant does intend to invoke 35 U.S.C. 112, sixth paragraph the applicant must amend the claim language to meet the above three prong analysis and clearly state on the record that 35 U.S.C. 112, sixth paragraph is being invoked.

Currently the examiner understands that the applicant is not invoking 35 U.S.C. 112, sixth paragraph since the claim language does not meet the three prong analysis and the applicant has never argued that 35 U.S.C. 112, sixth paragraph is being invoked.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-9, 24, 27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Low (US 439,786). Low discloses a desktop file organizer/carrying case comprising a plate (A), a plurality of vanes (D), each vane being attached at a respective first end to the plate (figure 5), the plate including a first side and a second side (figure 1), the first side being separated from the second side by the plurality of vanes (figure 2); means for securing the vanes to the plate (figure 2) the means comprising a band (F) attached to the plate through a hole (B) in the plate on one side, and a catch (g2, g3) on the plate on the other side (figure 1); wherein the vanes are securable against the plate by disposing the band across the vanes and on the catch (figure 2); the plate further including an handle (curved extensions forming opening G) comprising and opening (G) with an inner edge (figure 2), the catch comprising notches disposed in the inner edge of the opening (figure 2), the band further including two ends, the vanes being in between the ends of the band and the opening in the plate (figure 2), wherein the band is elastic (page 2, lines 50), wherein the catch is configured to engage the elastic band such that when the elastic band is disposed over the catch, the elastic band remains in a stretched configuration over the plurality of vanes (figures 2, 5 and 6) and wherein the organizer/carrying case can be disposed in a first horizontal

Art Unit: 3634

position for storing on a work surface, and a second upright position for carrying to a second location.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Low as applied to claim 7-9 above, and further in view of Ainsworth (US 2,149,489). Low fails to disclose a stiff material disposed on the band for reinforcement.

However, Ainsworth teaches a band (16) for retaining a plurality of vanes against a plate (figure1) wherein the band can include a metal ring at its ends (col. 2, lines 13-38) for reinforcement and providing a catch portion that wont wear as quickly as the elastic alone might .

Therefore, it would have been obvious to one of ordinary skill in the art to provide the organizer of Low, as advanced above, with metal reinforcement on the elastic band in order to provide a stronger, more wear resistant catch area on the band for prolonged use.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Low as applied to claims 27 and 29 above and further in view of Klein (US 2,177,071). Low fails

to disclose first and second portions separated by a fold line wherein the second portion can act as securing means.

Klein et al. discloses a desktop file organizer comprising a plate (13) including a first side and second side (figure 3), a top side and a bottom side (figure 6), first and second foldable sections (figure 2), and a plurality of vanes (12) having a first end and a second end (figure 8) wherein the second portion can be folded over the first portion (figure 1) for additional securing means of the vanes attached to the plate.

Therefore, it would have been obvious to one of ordinary skill in the art to provide the organizer of Low with first and second foldable portions as taught by Klein et al. in order to provide more attachment space for a plurality of vanes and to also provide additional securing means for holding the vanes by allowing the portions to fold over one another.

Claims 5, 6 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Low (US 439,786) in view of Klein et al. (US 2,177,071) and Dahl, Sr. (US 2,954,032). Low discloses a desktop file organizer comprising a plate (A), a plurality of flexible vanes (D), each vane being attached at a respective first end to the plate (figure 5), the plate including a first side and a second side (figure 1), the first side being separated from the second side by the plurality of vanes (figure 2); a band (F) attached to the plate through a hole (B) in the plate on the first side, and a catch (g2, g3) on the plate on the second side (figure 1); wherein the vanes are securable against

the plate by disposing the band across the vanes and on the catch (figure 2); the plate further including an handle (curved extensions forming opening G) comprising and opening (G) with an inner edge (figure 2), the catch comprising notches disposed in the inner edge of the opening (figure 2), the band further including two ends, the vanes being in between the ends of the band and the opening in the plate (figure 2), wherein the band is elastic (page 2, lines 50), wherein the catch is configured to engage the elastic band such that when the elastic band is disposed over the catch, the elastic band remains in a stretched configuration over the plurality of vanes (figures 2, 5 and 6). Low fails to disclose the vanes being disposed in slots along the plate and the vanes comprising tabs and tongues.

However, Klein et al. disclose a desktop file organizer comprising a plate (13) including a first side and second side (figure 3) and a top side and a bottom side (figure 6), a plurality of vanes (12) having a first end and a second end (figure 8) and attached along the length of the plate, starting from the first end (figure 3), wherein each vane includes two tabs (12aa) insertable into slots (16) along the plate and received on the underside of the plate (figure 2) for retaining the vanes. Although Klein et al. do not specifically disclose the slots to be spaced at one inch intervals, it would be an obvious design choice to one of ordinary skill in the art, to space the slots at whatever interval necessary to fulfill the user's needs for the organizer.

Additionally, Dahl, Sr. teaches a desktop file organizer (figure 1) comprising a plurality of vanes (64) having first and second ends, the vanes attached to base of the organizer (figure 3) by tabs (68) and tongues (70) extending from the first end of the

vanes, away from the second end (figure 3), wherein the tabs extend further from the second end than the tongues and the tab extend through slots (72) and the tongues are configured to rest upon the topside of the base and resist too much rotation by supporting the vanes' positions.

Therefore, it would have been obvious to one of ordinary skill in the art to provide the organizer of Low with the slot and tab securing system of Klein et al. and the tongue and tab structure of Dahl, Sr. in order to provide an organizer in which the vanes are securely attached along the plate for convenient filing purposes.

Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (US 2,177,071) in view of Miller (US 498,283) and Dahl, Sr. (US 2,954,032).

Klein et al. disclose a desktop file organizer comprising a plate (13) including a first side and second side (figure 3) and a top side and a bottom side (figure 6), a plurality of vanes (12) having a first end and a second end (figure 8) and attached along the length of the plate, starting from the first end (figure 3), wherein each vane includes two tabs (12aa) insertable into slots (16) along the plate and received on the underside of the plate (figure 2) for retaining the vanes. Although Klein et al. do not specifically disclose the slots to be spaced at one inch intervals, it would be an obvious design choice to one of ordinary skill in the art, to space the slots at whatever interval necessary to fulfill the user's needs for the organizer. Klein et al. fail to disclose a band for securing the vanes and the vanes to include a tongue, extending away from the second end of the vane.



However, Dahl, Sr. teaches a desktop file organizer (figure 1) comprising a plurality of vanes (64) having first and second ends, the vanes attached to base of the organizer (figure 3) by tabs (68) and tongues (70) extending from the first end of the vanes away from the second end (figure 3), wherein the tabs extend further from the second end than the tongues (figure 3) and the tabs extend through slots (72) and the tongues are configured to rest upon the topside of the base and resist too much rotation by supporting the vanes' positions.

Additionally, Miller teaches a file organizing system including a plate (7) having a first end and a second end, and first and second sides (figure 3), flexible vanes (unnumbered stack of papers), a handle (16) disposed in the plate and extending away from the vanes (figure 3) for handling the organizer, and an elastic band (12') for retaining the vanes in position wherein the band has two ends; one end of the band being disposed in a pair of holes (8) in the plate and an opening in the plate (opening catch 14 is inserted into) opposite the pair of holes (figure 3) includes a catch (14), the band being adapted to be disposed over the catch in the opening to constrain the plurality of the vanes against each other and the plate.

Therefore, it would have been obvious to one of ordinary skill in the art to provide the organizer of Klein et al. with the tongue and tab structure as taught by Dahl, Sr. and an elastic band and catch as taught by Miller in order to provide a file organizer in which the vanes are securely attached to the plate and including an easily disposed of means for constraining a plurality of vanes against the plate.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to COLLEEN M. QUINN whose telephone number is

Art Unit: 3634

(571)272-6289. The examiner can normally be reached on 8:30AM-5:00PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on (571) 272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHERINE W MITCHELL/  
Supervisory Patent Examiner, Art Unit 3634

/C. M. Q./  
Examiner, Art Unit 3634